

REMARKS

The present amendment addresses all of the issues raised by the examiner in the initial office action on the merits of May 21, 2004 and provides that all of the pending claims are directed toward a single distinct invention. Claims 1-8, 33, 35-36, 133-139, 159, 161 and 180-183 remain in the application. No new matter has been added and the pending claims are believed to be in condition for allowance. The applicant expressly reserves the right to pursue the previously cancelled and unclaimed subject matter as well as adopting possible further allowed claims for purposes of interference from pending allowed application 10/730,586 (or successors thereto) in a continuing and/or divisional application(s). The examiners comments will be addressed in turn.

DRAWING CORRECTIONS

The examiner has noted that the text on the game piece in figure 1 did not conform to the text noted in the specification due to an obvious typographical error. A replacement sheet having figures 1 and 2 thereon in which the game piece indicia "Queen Boildablock" has been changed to "Queen Buildablock" to conform to the specification has been added in this amendment. The examiner is thanked for pointing out this oversight and the objection is believed to be addressed with this amendment.

SPECIFICATION CORRECTION/ 35 U.S.C. 112 REJECTIONS

The examiner has rejected to the claims under 35 U.S.C. 112 first paragraph due to an alleged lacking of essential material. The examiner has suggested that the specification be amended to include the description of how to play the game from the provisional application. The specification has been amended to include the specific game play description from the provisional application in accordance with the Examiner's suggestion. The new paragraphs are added between paragraphs 7 and 8 and between paragraphs 61 and 62. The text is drawn from pages 3-7 and 15-29 of the aforementioned provisional patent application. The incorporation of this text is believed to address the issues raised by the examiner.

PRIOR ART REJECTIONS

CLAIM 1

Claim 1 has been rejected in view of the combined teachings of the Baca patent taken in view of the Powell patent. Claim 1 has been amended to define over the teachings of these references taken alone or in combination with the remaining prior art of record. Specifically claim 1 recites that in the method of playing the game according to the present invention and further includes the steps of:

building a first simulated structure on the playing surface using a first set of structural units, wherein at least a plurality of structural units are substantially identical;

at least partially disassembling the first simulated structure by removing at least some of the structural units therefrom; and

building a second simulated structure on the playing surface using a second set of structure units.

It is clear that neither the Baca or Powell patents teach or suggest these additional components of the present invention. As described in the specification the building of the simulated structures, e.g. the castle and tower, represent an important aspect of the game, as do the disassembly thereof, e.g. attacking the structures during simulated combat/siege. Finally, it should be clear that any individual component of the applicants invention can be found somewhere in the prior art, it is the combination of all of the claim elements that makes the present invention unique over the prior art of record. Claim 1 defines over the prior art of record for all of these reasons.

CLAIMS 2-3

Claim 2 depends from claim 1 and is allowable for all the reasons discussed above in connection with claim 1. Claim 2 defined that the independent indicia represent character attributes including at least combat characteristics and physical characteristics of the character, wherein combat characteristics are utilized in the mathematical combat resolution for the character. Further claim 2 now adds that at least some of the structural units forming the second simulated structure are also used in the first simulated structure. These features are believed to further distinguish the present invention from the teachings or reasonable suggestions of the prior art.

Claim 3 depends from claim 2 and is allowable for all the reasons discussed above in connection with claim 2.

CLAIM 4

Claim 4 depends from claim 3 and further defines that the physical characteristics represented on the independent indicia includes at least one of character type and movement values of the character. The examiner has rejected this claim in view of the combined teachings of the Baca patent taken in view of the Powell patent and further in view of the Matsumoto patent. The Matsumoto patent does not teach or suggest the features added to claim 1 discussed above. Further, there is simply no support to sift through the maze of prior art teachings and selectively combine these elements in the manner suggested by the examiner, absent the applicants own disclosure. The examiner is selectively ignoring the objects and purposes of the cited patents in this combination. Regardless, as to claim 4 there is no support for the claimed limitations as now set forth.

CLAIM 5

Claim 5 depends from claim 4 and is allowable for all of the reasons discussed above in connection with claim 4. Further, claim 5 has been amended to define that the disassembly step includes simulating a breach in the first simulated structure. This step, in combination with the remaining claim elements, is not taught or suggested in any reasonable combination of the prior art. Claim 5 further distinguishes the present claimed invention from the applied prior art.

CLAIM 6

Claim 6 depends from claim 5 and is allowable for all of the reasons discussed above in connection with claim 5. Further, claim 6 defines that the moving of the game pieces includes the step of measuring the movement with a measurement mechanism distinct from the playing surface. The examiner attempts to reject this claim in view of the combined teachings of the Baca patent as modified by the Powell patent as further

modified by the Matsumoto patent and finally in view of the Jorma patent. The Jorma patent does not cure the deficiencies of the earlier patents discussed above. Further, this fanciful combination of prior art references does not survive even minimal scrutiny. The specific references are discussed below in relation to the rejection of claim 7. Certainly the examiner can find every single aspect of the applicants claimed invention somewhere in the prior art. The existence of these components somewhere in the prior art does not meet the examiners burden and does not make the combination un-patentable. There must be some reason to support an examiners suggested combination. The only support for the suggested combination comes from the applicants own disclosure. This cannot support a rejection under 35 U.S.C. 103. Claim 6 defines over the prior art for all of these reasons.

CLAIM 7

Claim 7 has been written in independent form. The examiner has rejected the subject matter of claim 7 in view of the combined teachings of the Baca patent as modified by the Powell patent as further modified by the Matsumoto patent and finally in view of the Jorma patent. As noted above, this fanciful combination of prior art references will not survive even minimal scrutiny. Although the examiner can find every single aspect of the applicants claimed invention somewhere in the prior art. The existence of these components somewhere in the prior art does not meet the examiners burden and does not make the combination un-patentable. There must be some reason to support an examiners suggested combination. The only support for the suggested combination comes from the applicants own disclosure and is inappropriate.

The Baca patent is directed to a specific war gaming system and has as one of its stated objects "to provide a new wargame playing system which includes a game board having an playing surface [that] is illustrated to represent terrain and having a plurality of spaces, each the space having a type of terrain represented therein". The game pieces each have a given "cost" that is used to determine the "strength" of the unit as well. The movement of the pieces is determined by movement dice and "weather" dice.

Powell patent relates to a chess type board game, but which more accurately reflects the modern military condition. The key feature of the Powell patent game is that the pieces can be combined to form a combined amalgamated unit. The combined units will have a correspondingly decreased mobility factor.

The Matsumota patent is directed to a board game including a plurality of playing pieces provided with rotatably mounted carriages having surfaces thereof provided with multiple indicia indicating the number of moves that the playing pieces are permitted to make and magnets. The playing surface is divided into a plurality of contiguous areas on which the playing pieces are positioned and along which the playing pieces move, and a plurality of magnets positioned below the playing surface and arranged in a pre-determined pattern to attract the magnets of the playing pieces to rotate the carriages and the indicia different degrees as the playing pieces are moved from one area to another so as to continuously change the number of moves that the same playing pieces may make depending on their positions on the playing surface.

Finally the examiner relies upon the Jorma patent to show the presence of a measuring unit that is distinct from the playing surface.

First the examiner asserts that it would have been obvious to modify the device of Baca to include the multiple independent indicia for distinct character attributes as taught in Powell. The suggested combination would be of little use in the game described in the Baca patent. In considering this reference as a whole, there would be no teaching or suggestion to do so. In the Baca patent the cost of the character or game piece also determines the strength thereof. There would be no use for the suggested combination, other than in attempt to reconstruct the present claimed invention. Other game piece attributes, such as movement, are determined by the roll of various dice and attempting to form these as displayed indicia on the game piece would eliminate the random factor desired in the game of the Baca patent.

The examiner next suggests that it would be obvious to add the dial and aperture as taught by Matsumoto to the modified Baca/Powell game system. The Matsumoto structure has the dial coupled to magnets on the individual game pieces and game board to display various movement options that change due to game piece position as the piece

is moved about the playing surface. Combining this movement structure with the “modified” device of “Baca in view of Powell” would effectively destroy the objects and operation of BOTH the Baca and Powell patents. The Baca patent intends the movement of the game pieces to be controlled by random elements, including one representing the weather, and not the game piece position. The Matsomoto device has the game piece movement determined by the specific position it is on the board. The Powell patent intends, and has as a critical feature, that the game piece movement is effected by the size of the amalgamated piece. This operation is also lost if the movement is determined by a disc that will switch or change due to game board location.

Finally, the examiner modifies the combined teaching of these references in view of the Jorma patent “to have a board-less game”. This final modification defeats the stated object of ALL THREE EARLIER REFERENCES. A stated object of the Baca patent “to provide a new war-game playing system which includes a game board” of the stated design. This unique game-board is lost with the examiner’s suggested modification. The Powell patent intends to provide a chess like board game, a purpose which again is completely frustrated if the board where eliminated. Finally the key feature of the Matsumoto patent is the interaction of the game piece and the playing board, an interaction which is completely lost if the board where eliminated.

In building the examiners suggested combination of references the examiner has effectively destroyed the operation and objects of the individual patents. This combination cannot be said to be obvious to one of ordinary skill in the art. When these references are considered as a whole the clearly teach away from the claimed combination of the present claimed invention. The bits and pieces of the applicants claimed invention can always be found individually in the prior art. It is the combination of these items that is not fairly taught or suggested by the prior art when considered as a whole.

CLAIM 8

Claim 8 depends from claim 7 and is allowable for all the reasons discussed above in connection with claim 7. Claim 8 further defines the wheel indicia and the wherein the wheel indicia is selectively viewable through an aperture in a wheel body.

CLAIM 33

Claim 33 has been rejected as being clearly anticipated by the Matsumoto patent. The claim has been amended to clarify the method of playing a game simulating physical activities over the applied prior art taken alone or in combination with the remaining prior art of record. Initially, the Matsumoto patent is not directed to a game simulating a physical activity with game pieces representing game characters as in the present claimed invention. Further, the game pieces in Matsumoto cannot have a stretched interpretation of having both “a miniature figurine” thereon together with “multiple” character indicia thereon, as only movement and a pawn/king identifier is present. The pawn/king identifier is not believed to be a figurine and if it is stretched to read as a figurine then the “multiple” character indicia is lacking. The movement number in this prior art reference is fairly a “rotating element indicia” as set forth in the claim, and the character indicia in this reference is lacking (nor is there a need for such character indicia in the game defined in the Matsumoto patent. Finally there is no teaching or suggestion in this reference, taken alone or in any reasonable combination with the prior art of having at least one character indicia includes a first indicia portion that identifies the attribute and a second numerical indicia portion indicative of the value of the identified attribute (e.g. having the Attack value listed as an identifying “AT” followed by the number or the total movement value noted as “MV” followed by the number or the range as “RA” followed by the number value of the attribute).

Claim 33 is also rejected in view of the combined teachings of the Baca patent taken in view of the Powell patent and further in view of the Matsumoto patent. There is no teaching or suggestion in these references, taken alone or in any reasonable combination thereof, of having at least one character indicia includes a first indicia portion that identifies the attribute and a second numerical indicia portion indicative of

the value of the identified attribute. Further, the specific teachings of these patents teach away from the suggested combination as discussed above in connection with claim 7.

CLAIM 35

Claim 35 depends from claim 33 and is allowable for the reasons discussed above in connection with claim 33. Claim 35 further defines that the character indicia, as opposed to the rotating element indicia, is selected from the group consisting of text, letters, numbers and combinations thereof and further that at least one of the character indicia is not associated with the rotating element indicia. These features are not found in the Matsumoto patent, taken alone or in combination with the remaining cited references.

CLAIM 36

Claim 36 depends from claim 35 and is allowable for the reasons discussed above in connection with claim 35. Claim 36 further limits the invention to utilizing randomizing elements for combat dispute resolution.

CLAIM 133

Claim 133 has been amended to clarify and define that the invention includes (1) positioning at least one simulated building on the playing surface, wherein each simulated building is formed of a plurality of structural units that are adapted to form a plurality of simulated structures, and (2) simulating breaching of at least one simulated structure in at least one said simulated combat step. These additional steps are not fairly taught or suggested in the applied prior art. This claim is rejected in view of the combined teachings of the Baca patent taken in view of the Powel patent and further in view of the Jorma patent. The arguments against this fanciful combination are set forth above in connection with claim 7 (which also addresses the inappropriate combination of the Matsumoto patent).

CLAIMS 134-135

Claims 134-135 further define features of the present claimed invention which it is not clear how they are intended to be found in the suggested combination of prior art references. These claims are believed to separately define over the prior art of record.

CLAIM 136

Claim 136 depends from claim 135 and further define that the physical characteristics represented on the independent indicia includes at least one of character type and movement values of the character. This claim is rejected in view of the combination of the Baca patent taken in view of the Powell patent taken in view of the Matsumoto patent and finally taken in view of the Jorma patent. The deficiencies of this combination were addressed above in connection with claim 7.

CLAIMS 137-139

Independent claim 137 is directed to a method of playing a miniature war game on a playing surface with a plurality of game pieces, wherein selected game pieces are representative of individual characters of the game. Each game piece represents a character and has multiple, independent visible indicia indicative of distinct character attributes thereon. Further, range values of the game pieces are measured with a movement measuring device distinct from the playing surface, and simulated structures are positioned on the playing surface, wherein the independent indicia represent character attributes including at least combat characteristics and physical characteristics of the character, wherein combat characteristics are utilized in the mathematical combat resolution for the character, wherein the combat characteristics represented on the independent indicia includes at least one of attack values and range values for the character, and wherein the indicia identifies both the value of the attribute and the associated attribute, wherein the physical characteristics represented on the independent indicia includes at least one of character type and movement values of the character, and wherein the randomizing element includes at least one die, and at least one simulated structure is a simulated castle.

In an effort to find these claimed elements the Examiner relies upon the teachings of the Baca patent taken in view of the Powell patent taken in view of the Motsumoto Patent taken in view of the Jorma patent (similar to claim 7 above) and finally taken in view of the Rhea patent. The Baca/Powell/Matsumoto/Jorma combination is inappropriate as discussed above. Further, the Rhea patent is a design patent illustrating a toy castle structure. Applicants admit that toy castle structures exist, but that does not suggest it would be obvious to combine such with the teachings of the Baca/Powell/Matsumoto/Jorma combination.

Claims 138 and 139 depend, directly or indirectly from claim 137 and are allowable for the reasons discussed above. Further claim 139 defines that the independent indicia includes a first indicia portion that identifies the attribute and a second indicia portion indicative of the value of the identified attribute. This is not found in the prior art as discussed above.

CLAIMS 159 and 161

Claim 159 now depends from claim 33 and is allowable for the reasons discussed above in connection with claim 33. Claim 159 further defines the steps of (1) providing a plurality of structural units for forming a variety of simulated structures, and (2) building and placing selected simulated structures on the playing surface. The applied prior art does not fairly teach or suggest the plurality of structural units for forming a variety of simulated structures, and building the same in combination with the remaining claim elements. Claim 161 depends from claim 159 and is allowable for the reasons discussed above in connection with claim 159.

CLAIM 180

New claim 180 defines a method of playing a competitive fantasy game including providing a plurality of game-pieces with each game-piece representative of a game character, wherein each game-piece includes i) a miniature figurine, wherein at least some of the game pieces includes figurines selected from the group consisting of humans, humanoids, monsters, and siege weapons, ii) multiple character indicia thereon, wherein the character indicia is indicative of character attributes of the character including at least

the name of the character, and iii) a rotating element having multiple rotating element indicia thereon, at least one rotating element indicia associated with movement of the game piece, and wherein at least one character indicia is associated with at least one of the rotating element indicia. This combination of elements is not found in any reasonable interpretation of the prior art. Miniature figurines are certainly known as are character indicia on game pieces and rotating elements for variable information of a game piece. However, the defined combination of these elements together with the relationship between the character indicia and the rotating element indicia is not found in the prior art of record.

CLAIMS 182 and 183 See Application Serial Number 09/958,201

New claim 182 corresponds to allowed independent claim 50 (as amended) of U.S. Application Serial No. 09/958,201. The applicants are adopting this claim to provoke an interference between such application (or patent) and the present application as applicant believes that the language of this allowed claim is fully supported in the present application. Further the applicant believes he is the first to invent this subject matter. The following is a copy of the claim with reference numerals or text in italics to evidence support for the claimed language.

182. A game piece [*element 10 of the instant application*] for use in a game, the game piece [*10*] comprising:

a self-contained record-keeping device [*formed by the combination of the indicia 12 and the indicia 54*], wherein the record-keeping device adjustably displays variable information relating to the game [*Indicia 54 displays variable information such as the remaining amount of range or movement that a character has at a given point in a given movement – such as along path D in figure 1*], the information being arranged in a plurality of selectable groupings of game play indicia [*Each grouping consists of the combination of the character indicia (fixed indicia) 12 and the variable indicia that changes along the measured path*] , each grouping including a plurality of different types of game play indicia [*Each grouping includes the name of the character, Attack values, Maximum Move values, Maximum Range values (if a projectile throwing character) and either the*

remaining range or movement value left at a given position during a move], each type of indicia indicating information related to a different aspect of the play of the game and being expressed as game play values [The attack, Total Move and Total Range are expressed as game play values and the wheel indicia 54 may be in form of text, numerical values, symbols as discussed in the specification], the indicia of one type in at least some of the groupings having game play values different from the indicia of the same type in others of the groupings[See fig 2 in which Attack total move and total range can vary for different pieces and the displayed measured range or movement value representing the remaining amount will decrease as the piece moves along the path D or the path of the projectile] ;

an indicator [items 50 and 52 which may be integral with the game piece 10] selectively manually movable [52 is manually rolled along the ground] between a plurality of positions corresponding to the groupings to select one of the groupings for use of the game play indicia thereof to determine game play [at each path along the movement the displayed value determines game play by indicating how much of the movement/range has been used and is remaining which will change the game play such as stopping a players movement at the end a movement or allowing the character to take a circuitous path around objects] , the indicator [50,52] including an aperture [see figures 8-9] in a member [50], the member [50] being selectively movable to align the aperture with the selected one of the groupings to allow viewing of the indicia [54 and 12] of the selected grouping [only one of the indicia 54 will be visible] to determine game play.

New claim 183 corresponds to allowed independent claim 92 of U.S. Application Serial No. 09/958,201. The applicants are adopting this claim to provoke an interference between such application (or patent) and the present application as applicant believes that the language of this allowed claim is fully supported in the present application. Further the applicant believes he is the first to invent this subject matter. The following is a copy of the claim with reference numerals in italics to evidence support for the claimed language which is similar to claim 182 discussed above (therefore only the reference numerals for the items are added below)

183. A movable game piece [10] for use in playing a game, the game piece [10] comprising:

a first member [10] having a plurality of discrete groupings of game play indicia [12, 54], each grouping including a plurality of different types of game play indicia, each type of indicia indicating information related to a different aspect of play of the game; and

a second member [50] having an indicator portion positioned to indicate one of the groupings for use of the indicia thereof to determine game play, one of the first and second members having a contact portion [52] and being selectively manually movable relative to the other of the first and second members in response to a user manually drivingly contacting the contact portion to selectively position the indicator portion indicate the one of the groupings.

CLAIM 181

New claim 181 is similar to adopted claim 182 discussed above. However claim 181 further defines the fixed indicia (character indicia 12) and the variable indicia (Indicia 54 on the wheel 52). The claim is allowable for the as is claim 182, further the claim recites the fixed and variable indicia and the relationship there between that is not found in any of the prior art.

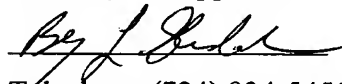
It is respectfully submitted that the application is in condition for allowance. A favorable action is respectfully requested.

Respectfully Submitted;

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{Drawing Replacement Sheet attached as non-numbered final page}

AMENDMENTS TO THE DRAWINGS

Please replace figures 1 and 2 with the replacement sheet attached hereto and having figures 1 and 2 thereon in which the game piece indicia “Queen Boildablock” has been changed to “Queen Buildablock” to conform to the specification.